REMARKS

Claims 1-24 are pending, with claims 1, 10, 19, and 24 being independent. The Office's objections to the Specification and claims 2, 9, 18, and 22 have been addressed. Claims 2, 9, 18, and 22 have been amended. No new matter has been added. Reconsideration and allowance of the above-referenced application are respectfully requested.

Rejections Under 35 U.S.C. § 112, first paragraph

Claim 1 stands rejected under 35 U.S.C. § 112, first paragraph for allegedly not meeting the enablement requirement. The Office's contention is respectfully traversed. The Applicant has provided sufficient disclosure to enable one skilled in the art to practice the claimed invention without undue experimentation. For example, Applicant discloses that "[i]n general, **unexpected changes** or **unexpected lack of changes** caused by an install are presented to a system, process and/or person. Input specifying one or more of the identified resources that **should be static** in their installation result for future software installations can be received at 130. A **new expectation of stability** for the specified resources can be designated according to the received input at 140. ... Additionally, input of a **converse nature** can be received and acted upon as well (e.g., input specifying an aspect of a resource to be **designated as volatile** for future installs, thereby **changing a current expectation of stability** for that aspect of the resource)." (Emphases added; page 6, paragraph [0025] of the application as filed; *see also*, Figure 1, element 140 stating "designate a **new expectation of stability** ...")

Further, the Office mistakenly identified and examined claim 1 as a "single means claim" under MPEP § 2164.08(a). Claim 1 is not a single means claim because it recites "... **creating data** that represents a new expectation ...." Indeed, courts have held that "not everything necessary to practice the invention need be disclosed" (MPEP § 2164.08 citing *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991)) and "the scope of enablement must only bear a 'reasonable correlation' to the scope of the claims" (MPEP § 2164.08 citing *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970)). Therefore, withdrawal of the rejection of claim 1 under 35 U.S.C. § 112, first paragraph is respectfully requested.

Rejections Under 35 U.S.C. § 112, second paragraph

Claim 22 stands rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. This contention is respectfully traversed. One skilled in the art would understand the meaning of SKU given the original disclosure. The acronym SKU has now been expressly defined in the Specification. Therefore, withdrawal of the rejection of claim 22 under 35 U.S.C. § 112, second paragraph is respectfully requested.

Rejections Under 35 U.S.C. § 101

Claims 1-3, 10-12, and 24 stand rejected under 35 U.S.C. § 101 as allegedly not being directed to statutory subject matter. The Applicant respectfully traverse these contentions by the Office. The Federal Circuit has long held that the **claimed invention as a whole** must be useful and accomplish a practical application; i.e., it must produce a "useful, concrete and tangible result." (*State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998).) Claim 1 recites, among other features: "**creating data that represents a new expectation** for an installation result, ..., the new expectation being a transition from an expectation of volatility to an expectation of stability for future software installs." (Emphasis added.) Claim 1, as a whole, is useful and accomplishes a practical application by "creating data that represents a new expectation" (tangible output) for use by a user in tracking and verifying software installation.

Further, the Applicant discloses the utility and practical application of the claims by stating "a change-tracking system using the systems and techniques described can be **used to verify** correct installation of a software product with many resources that are being changed frequently (e.g., daily). ... A system employing the present techniques can **track what should actually be installed** on a particular day in a software product's life-cycle, including components that need to be installed in other applications' directories, and quickly call attention to inadvertently introduced errors. This can be **of particular value** in the latter part of a software product's development life-cycle, when engineers may be struggling to meet a set product release date." (Emphases added; page 3, paragraph [0009] of the application as filed.) Therefore, withdrawal of the rejection of claim 1 under 35 U.S.C. § 101 is respectfully requested.

Additionally, claims 2-3 depend from claim 1 and their rejections should also be withdrawn for at least the reasons provided above.

Claim 2 recites, among other features: "**generating** a comparison ...; and **identifying**, based on the comparison, resources that have changed" (emphases added). Claim 2, as a whole, is also useful and accomplishes a practical application by producing tangible results for use by a user in tracking and verifying software installation. Thus, withdrawal of the rejection of claim 2 under 35 U.S.C. § 101 is respectfully requested.

Claim 3 recites, among other features: "**identifying**, based on the comparison, resources that have not change in their installation result" (emphasis added). Claim 3, as a whole, is also useful and accomplishes a practical application by producing tangible results for use by a user in tracking and verifying software installation. Therefore, withdrawal of the rejection of claim 3 under 35 U.S.C. § 101 is respectfully requested.

Claim 10 recites, among other features: "A software product **tangibly embodied** in a machine-readable medium, the software product comprising instructions operable to cause one or more data processing apparatus to perform operations comprising: **generating a comparison** of a current software installation with a previous software installation; and **identifying**, based on the comparison, **resources that have not changed** in their installation result from the previous software installation to the current software installation, despite an expectation that the unchanged resources should change from the previous software installation to the current software installation." (Emphases added.) Claim 10, as a whole, produces a "useful, concrete and tangible result" for use by a user by "generating a comparison" and "identifying" "resources that have not changed" for tracking and verifying software installation. Therefore, withdrawal of the rejection of claim 10 under 35 U.S.C. § 101 is respectfully requested. Additionally, claims 11-12 depend from claim 10 and their rejections should also be withdrawn for at least the reasons provided above.

Claim 24 recites, among other features: "means for **generating a current install comparison** ...; means for **generating a software trend comparison** ...; means for **comparing the software trend comparison** with a record of installation expectations ...; and means for

presenting potential problems ..." (emphases added). The Office's contention that claim 24 is directed to "software alone" is respectfully traversed. Claim 24 invokes 35 U.S.C. § 112, sixth paragraph because it recites the phrase "means for" modified by functional language. (*See, e.g.*, MPEP § 2181.) Further, the Applicant sufficiently disclosed specific corresponding structure or equivalents thereof for the limitations of claim 24. (*See, e.g.*, page 8, paragraph [0030] of the application as filed, stating that "FIG. 4 is a block diagram illustrating a **system** 400 that can be used to perform software installation verification." (emphasis added); *see also*, FIG. 4 and FIG. 5 of the application as filed). Therefore, claim 24 is directed to statutory subject matter and withdrawal of the rejection of claim 24 under 35 U.S.C. § 101 is respectfully requested.

Rejections Under 35 U.S.C. § 102

Claims 1-6, 10, 12-15 and 24 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,560,776 issued to Breggin et al. (hereinafter "Breggin"). This contention is respectfully traversed.

Breggin does not teach each and every element of claim 1. Claim 1 recites, among other features: "creating data that represents a **new expectation** for an installation result, ..., the new expectation being a **transition** from an **expectation of volatility** to an **expectation of stability** for future software installs." (Emphases added) The Applicant states in the application as filed that "[t]he expected results can include **expectations of change** in a resource's installation result (i.e., the resource is **expected to be in flux** from one install test to the next), and the expected results can also include **expectations of no change** in a resource's installation result (i.e., the resource is **expected to be stable** from one install test to the next)." (Emphases added; page 6, paragraph [0024].) Contrarily, Breggin teaches that "[a]fter the processor has read all of the installation script in box 100, the processor in box 188 (FIG. 1) **creates a list** of program files, data files, and registry entry changes." (Emphasis added; 7:23-25.) Although Breggin's "method and system automatically generates an installation file or database" (1:62-64), Breggin simply does not teach the limitations of "new expectation for an installation result" and "the new expectation being a transition from an expectation of volatility to an expectation of stability for

future software installs" as recited in claim 1. Thus, Breggin does not teach each and every element and limitation of claim 1, and claim 1 should be in condition for allowance.

Claim 10 recites, among other features: "**identifying**, based on the comparison, **resources that have not changed** in their installation result from the previous software installation to the current software installation, despite an expectation that the unchanged resources should change from the previous software installation to the current software installation." By comparison, Breggin teaches identifying "exceptions" where an "exception is typically a **difference between corresponding fields** in the installation and installed databases or files. Examples of exceptions include 'file is missing,' 'file is different size,' ..." (emphases added; 9:55-61). Breggin's identification of "exception" stands in sharp contrast with "identifying ... resources that have not changed" as recited in claim 10. Therefore, Breggin does not teach each and every element and limitation of claim 10, and claim 10 should be in condition for allowance.

Claims 2-6 and 12-15 depend generally from claims 1 or 10, and are allowable for at least the reasons provided above.

Additionally, claim 5 is a dependent claim which depends from claims 1, 2, and 4 and recites "tracking expectations for the resources in a **primary installation baseline** and a **secondary installation baseline**, and wherein presenting the potential problems comprises presenting a baseline-update interface by transmitting markup language data." (Emphases added.) The Applicant discloses that "[i]n general, the **primary baseline** represents what is added to and modified in a computing system during a product installation and can represent what should be installed; the **secondary baseline** represents how installed resources are changing (i.e., if they are changing or not changing in one or more attributes) from one product version installation to the next." (Emphases added; page 7, paragraph [0027] of the application as filed.) Moreover, "changes to software installations can be tracked using a **two-stage differencing scheme**. The first stage can find the differences between a clean system and an installed system (e.g., deletions, additions, and changes to the file system and any system registry), and the second stage can find differences between results in the first stage over

multiple install tests of a changing software product." (Emphasis added; page 6, paragraph [0023] of the application as filed.)

In contrast, Breggin merely teaches that "a baseline file, which is simply a "snapshot" of the exceptions on the target computer at a given time, is generated manually or automatically." (10:50-52.) Breggin simply does not teach "tracking expectations for the resources in a primary installation baseline and a secondary installation baseline ..." as recited in claim 5. Therefore, claim 5 should be allowable for at least this additional reason.

Regarding claim 24, the Office states that "[w]hile the claim meets the first prong of the three-prong analysis used to determine invocation of 35 U.S.C. 112, sixth paragraph, the claim does not meet the other prongs of the three-prong analysis, since no other specific corresponding structure or equivalents thereof are disclosed in the specification." The Applicant respectfully traverse this contention.

Claim 24 recites, among other features: "means for **generating a current install comparison** ...; means for **generating a software trend comparison** ...; means for **comparing the software trend comparison** with a record of installation expectations ...; and means for **presenting potential problems** ..." (emphases added). Claim 24 clearly invokes 35 U.S.C. § 112, sixth paragraph because it recites the phrase "means for" modified by functional language. (*See, e.g.*, MPEP § 2181.) Indeed, the Applicant sufficiently disclosed specific corresponding structure or equivalents thereof for the limitations of claim 24. (*See, e.g.*, page 8, paragraph [0030] of the application as filed, stating that "FIG. 4 is a block diagram illustrating a **system** 400 that can be used to perform software installation verification." (emphasis added); *see also*, FIG. 4 and FIG. 5 of the application as filed). One skilled in the relevant art would clearly understand that this description encompasses various combinations of hardware and software, and that system 24 is not directed to software alone.

Further, claim 24 recites, among other features: "the software trend comparison **indicating which of the resources have not changed** in the at least one attribute from the previous install to the current install; ... which of the resources **should be in flux**, and which of the resources **should be stable** from the previous install to the current install" (emphases added).

Thus, claim 24 is patentable for at least similar reasons to those discussed above in connection with claims 1, 5, and 10.

Rejections Under 35 U.S.C. § 103

Claims 7-9 and 16-18 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Breggin. This contention is respectfully traversed. A *prima facie* case of obviousness has not been established because Breggin does not teach or suggest all the elements of claims 7-9 and 16-18. For example, claims 7-9 and 16-18 depend generally from independent claims 1 and 10. As discussed above, Breggin does not teach or suggest every element and limitation of claims 1 and 10. Furthermore, the Office uses improper hindsight reconstruction to reject claims 7-9 and 16-18 because the only motivation for the missing elements of Breggin is Applicant's own disclosure and claim language. Thus, Breggin does not teach or suggest each and every element of claims 7-9 and 16-18 at least for the reasons above, and claims 7-9 and 16-18 should be allowable.

Claims 11, 19, 20, 22 and 23 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Breggin in view of U.S. Patent No. 6,738,970 issued to Kruger et al. (hereinafter "Kruger"). This contention is respectfully traversed. Kruger does not cure the deficiencies of Breggin. A *prima facie* case of obviousness has not been established because the suggested Breggin-Kruger combination does not teach or suggest all the elements of claims 11, 19, 20, 22 and 23. For example, claim 11 depends from independent claim 10 and, as discussed above, Breggin does not teach or suggest every element and limitation of claim 10.

Regarding independent claim 19, the Office mistakenly equates Breggin's teaching of an "installation database" (Figure 1, element 200; 7:47-49) with the element of "install controller" recited in claim 19. The Applicant discloses that "[a]n install controller 420 **manages** the **install testing process** using the techniques described above **and a database** 430. The install controller 420 can and/or the system under test 410 can **communicate results to the database** 430." (Emphases added; page 8, paragraph [0030].) Therefore, the claimed "install controller" is not the same as an "installation database."

Further, the Office mistakenly equates Breggin's teaching of "the (build) computer ... creates a list of program files ... and writes certain of this information to the installation database" (4:16-21) with the element of "the build controller **automatically triggers** the install controller to **initiate installer tests** ..." (emphasis added) recited in claim 19. The Applicant discloses that "The build controller 510 communicates with the install controller 520 to **trigger installer tests**, and in response, the install controller 520 automatically **obtains installers** from the build controller 510." (Emphases added; page 11, paragraph [0038].) Contrarily, Breggin's teaching of "creat[ing]" and "writ[ing]" to the "installation database" is not the same as "trigger[ing] the install controller to initiate installer tests" as in claim 19. Therefore, the suggested Breggin-Kruger combination does not teach or suggest all the elements of claim 19, and claim 19 should be allowed.

Claims 20, 22, and 23 depend from independent claim 19, and these dependent claims are allowable for at least the reasons provided above.

Claim 21 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Breggin in view of Kruger, and further in view of U.S. Patent Application No. 2002/0156831 by Suorsa et al. (hereinafter "Suorsa"). This contention is respectfully traversed. Suorsa does not cure the deficiencies of Kruger over Breggin and a *prima facie* case of obviousness has not been established for this claim. Since claim 21 depends from claim 19, claim 21 is allowable for at least the reasons stated above.

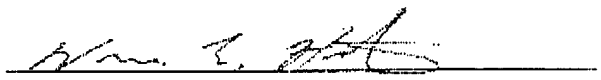
CONCLUSION

The foregoing comments made with respect to the positions taken in the Office Action are not to be construed as acquiescence with other positions taken in the Office Action that have not been contested. Accordingly, the above arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claim or other claims.

A formal Notice of Allowance is respectfully requested. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: September 26, 2006



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